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Application Number **10707676**

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**IDS Flag Clearance for Application 10707676**

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**IDS Information**

Content	Mailroom Date	Entry Number	IDS Review	Last Modified	Reviewer
WIDS	2005-12-19	13	Y <input checked="" type="checkbox"/>	2007-05-09 00:00:00.0	CR #232884
<b>Update</b>					

*updated*

*Hg*

*NONE*

*08/16/2007*

## Lilling, Herbert J.

**From:** Doll, John  
**Sent:** Thursday, August 09, 2007 5:57 PM  
**To:** Patents\_all\_Employees  
**Subject:** Announcement of Notice of Proposed Rulemaking - Alternative Claims

Hello everybody !!!

Because of the critical role you play as patent examiners in fostering innovation and competitiveness across all technologies, I wanted to share with you a new rules proposal that is expected to be published in the Federal Register tomorrow (Friday, August 10, 2007).

The proposed new rules could impact patent applications in all art areas, but will likely have the greatest impact on biotechnology, chemical, and pharmaceutical technologies. The rules will improve an examiner's ability to focus the examination process for claims that contain more than one independent and distinct invention.

The search and examination of alternative (Markush) claims, especially in TC 1600 and TC 1700, can consume a disproportionate amount of Office resources compared to other types of claims because a separate search and examination of each alternative may be required to fully address the entire scope of these claims. For example, the chemical structures typical of a Markush claim are very expensive to search because they require a chemical structure search using costly commercial databases. In an effort to level the playing field for all and provide a more efficient, thorough and quality examination, the Office is proposing rule changes that will require those applicants who choose to draft claims that include alternatives to maintain a certain degree of relatedness among them.

### Brief Summary of Proposed Rule Changes:

1. A claim must be limited to a single invention.
2. Intra-claim restriction would be permissible when there is no unity of invention among the alternatives using the *Harnisch Test*: All the species must share a substantial feature essential for a common utility.
3. Any claim that recites both an elected and a non-elected invention in the alternative will be objected to.
  - Any non-elected invention must be canceled before the claim will be allowed, subject to reconsideration and review.
4. Applicants must identify which claims are disclosed in prior-filed applications (CIP, provisional, and foreign applications).
5. A claim may not incorporate another part of the specification by reference, unless there is no other practical way to define the invention.
  - If a claim incorporates another part of the specification by reference, and that portion sets forth alternatives, the claim will be treated as an alternative claim.
6. A claim using alternative language must be in the proper format:
  - Each alternative must be substitutable one for another.
  - No alternative is encompassed by any other alternative, unless there is no other practical way to claim
  - No alternative is defined as a set of further alternatives within the claim.
  - The number and presentation of alternatives in the claim must not make the claim difficult to construe.

I would like to thank those persons who participated in earlier focus sessions and provided suggestions for these proposed rules and worked on drafting the proposed rule changes. The proposed rules were guided by TC 1600 Group Director John LeGuyader, who worked diligently with managers, examiners and legal staff from various business units, as well as a POPA representative.

The team was:

Team Lead: John LeGuyader  
Solicitor's Office: Steve Walsh and Janet Gongola  
DCPEP: Linda Therkorn, Bob Bahr, Brian Hearn, Kathleen Fonda and Karen Hastings  
TC1600: Julie Burke and Jeanine Goldberg  
TC1700: Larry Tarazano  
OIR: James Housel  
POPA: Adrienne Johnston

The Office will collect and consider comments from the public until October 9, 2007, and then finalize rule changes to address these alternative or Markush-type claims based on an assessment of the comments received. We would also value any comments, questions, and suggestions you may have on the proposed new rules. Please send your feedback to:  
[mailto:Alternative\\_Claim\\_NPR\\_Markush@uspto.gov](mailto:Alternative_Claim_NPR_Markush@uspto.gov).

Keep up the great work !!!

John Doll  
Commissioner for Patents

10/707674.

# ATCC

AMENDED 6/29/05

16801 University Blvd • Manassas, VA 20110-2209 • Telephone: 703-365-2700 • FAX: 703-365-2745

BUDAPEST TREATY ON THE INTERNATIONAL RECOGNITION OF  
THE DEPOSIT OF MICROORGANISMS FOR THE PURPOSES OF PATENT PROCEDURE

**INTERNATIONAL FORM**

**RECEIPT IN THE CASE OF AN ORIGINAL DEPOSIT ISSUED PURSUANT TO RULE 7.3  
AND VIABILITY STATEMENT ISSUED PURSUANT TO RULE 10.**

To: (Name and Address of Depositor or Attorney)

Nutrition Physiology Corporation  
Attn: Matthew R. Garner  
1105 Hanshaw Road  
Ithaca, NY 14850

Deposited on Behalf of: Nutrition Physiology Corporation

**Identification Reference by Depositor:**

Lactobacillus acidophilus: C28  
Lactobacillus acidophilus: LA45  
Lactobacillus acidophilus: LA51  
Lactobacillus acidophilus: M35  
Propionibacterium freudenreichii: PF24

**Patent Deposit Designation**

PTA-6748  
PTA-6749  
PTA-6750  
PTA-6751  
PTA-6752

The deposits were accompanied by:        a scientific description, a proposed taxonomic description indicated above. The deposits were received May 26, 2005 by this International Depository Authority and have been accepted.

AT YOUR REQUEST:  We will inform you of requests for the strains for 30 years.

The strains will be made available if a patent office signatory to the Budapest Treaty certifies one's right to receive, or if a U.S. Patent is issued citing the strains, and ATCC is instructed by the United States Patent & Trademark Office or the depositor to release said strains.

If the cultures should die or be destroyed during the effective term of the deposit, it shall be your responsibility to replace them with living cultures of the same.

The strains will be maintained for a period of at least 30 years from date of deposit, or five years after the most recent request for a sample, whichever is longer. The United States and many other countries are signatory to the Budapest Treaty.

The viability of the cultures cited above was tested June 6, 2005. On that date, the cultures were viable.

International Depository Authority: American Type Culture Collection, Manassas, VA 20110-2209 USA.

Signature of person having authority to represent ATCC:

Marie Harris  
Marie Harris, Patent Specialist, ATCC Patent Depository

Date: June 21, 2005

cc: Greg Novak  
Docket or Case No: 52330004CNSU04; -DVUS06; -DVUS07; -DVUS08

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# ATCC

1020 University Blvd • Manassas, VA 20110-2209 • Telephone: 703-365-2700 • FAX: 703-365-2745

## BUDAPEST TREATY ON THE INTERNATIONAL RECOGNITION OF THE DEPOSIT OF MICROORGANISMS FOR THE PURPOSES OF PATENT PROCEDURE

### INTERNATIONAL FORM

#### RECEIPT IN THE CASE OF AN ORIGINAL DEPOSIT ISSUED PURSUANT TO RULE 7.3 AND VIABILITY STATEMENT ISSUED PURSUANT TO RULE 19.

To: (Name and Address of Depositor or Attorney)

Nutrition Physiology Corporation  
Attn: Matthew R. Garner  
1105 University Rd.  
Ithaca, NY 14850

Deposited on Behalf of: Nutrition Physiology Corporation

International Reference by Depositor:

Lactobacillus acidophilus: T411  
Propionibacterium jensenii: P9  
Propionibacterium acidipropionicum: P42

Patent Deposit Designation

PTA-6820  
PTA-6821  
PTA-6822

The deposits were accompanied by: a scientific description, a proposed taxonomic description indicated above. The deposits were received June 30, 2004 by the International Depository Authority and have been accepted.

AT YOUR REQUEST:  We will inform you of requests for the strains for 30 years.

The strains will be made available if a patent office signatory to the Budapest Treaty certifies one's right to receive, or if a U.S. Patent is issued citing the strains, and ATCC is instructed by the United States Patent & Trademark Office or the depositor to release said strains.

If the cultures should die or be destroyed during the effective term of the deposit, it shall be your responsibility to replace them with living cultures of the same.

The strains will be maintained for a period of at least 30 years from date of deposit, or five years after the most recent request for a sample, whichever is longer. The United States and many other countries are signatory to the Budapest Treaty.

The viability of the cultures cited above was tested July 5, 2005. On that date, the cultures were viable.

International Depository Authority: American Type Culture Collection, Manassas, VA 20110-2209 USA.

Signature of person having authority to represent ATCC:

*Marie Harris*  
\_\_\_\_\_  
Marie Harris, Patent Specialist, ATCC Patent Depository

Date: September 19, 2005

cc: Greg Novak  
Docket or Case No: 5233U004CN1E04; -DVUS06; -DVUS07; -DVUS08

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# ATCC

10801 University Blvd • Manassas, VA 20110-2209 • Telephone: 703-365-2700 • FAX: 703-365-2745

## BUDAPEST TREATY ON THE INTERNATIONAL RECOGNITION OF THE DEPOSIT OF MICROORGANISMS FOR THE PURPOSES OF PATENT PROCEDURE

### INTERNATIONAL FORM

#### RECEIPT IN THE CASE OF AN ORIGINAL DEPOSIT ISSUED PURSUANT TO RULE 7.3 AND VIABILITY STATEMENT ISSUED PURSUANT TO RULE 10.

To: (Name and Address of Depositor or Attorney)

Cornell University  
Attn: Matthew R. Garner, Ph.D.  
Department of Food Science  
Stocking Hall  
Ithaca, NY 14853

Deposited on Behalf of: Nutrition Physiology Corporation

Identification Reference by Depositor:

Patent Deposit Designation

Lactococcus lactis: L7  
Pediococcus acidilactici: D3

PTA-7425  
PTA-7426

The deposits were accompanied by:  a scientific description, a proposed taxonomic description indicated above. The deposits were received March 8, 2006 by this International Depository Authority and have been accepted.

AT YOUR REQUEST:  We will inform you of requests for the strains for 30 years.

The strains will be made available if a patent office signatory to the Budapest Treaty certifies one's right to receive, or if a U.S. Patent is issued citing the strains, and ATCC is instructed by the United States Patent & Trademark Office or the depositor to release said strains.

If the cultures should die or be destroyed during the effective term of the deposit, it shall be your responsibility to replace them with living cultures of the same.

The strains will be maintained for a period of at least 30 years from date of deposit, or five years after the most recent request for a sample, whichever is longer. The United States and many other countries are signatory to the Budapest Treaty.

The viability of the cultures cited above was tested March 14, 2006. On that date, the cultures were viable.

International Depository Authority: American Type Culture Collection, Manassas, VA 20110-2209 USA.

Signature of person having authority to represent ATCC:

  
Tanya Nurnally, Patent Specialist, ATCC Patent Depository

Date: March 28, 2006

cc: Tracy Druce  
(Ref.: Docket or Case No. 5233.0009.NPUS01)

**REMARKS**

All comments and remarks of record are herein incorporated by reference. Applicants respectfully traverse these rejections and all comments made in the Office Action. Nevertheless, in an effort to expedite prosecution, Applicants provide the following remarks regarding the cited references.

**DISPOSITION OF CLAIMS**

Claims 1-14, and 16-28 are pending in the application. Claims 1, 12, 16 and 26 have been amended for clarification. No new matter has been added.

**TELEPHONE INTERVIEW**

Applicants respectfully thank the Examiner for granting a telephone interview on August 16, 2007. With this reply, the Applicants adopt the Examiner's suggested amendments to claims 1, 12, 16, and 26. Furthermore, in line with the Examiner's suggestion, Applicants provide a statement herewith regarding biological material.

**BIOLOGICAL MATERIAL**

Applicants respectfully assert that the Applicants have made deposits of the above mentioned microorganisms with a depository under the Budapest Treaty and which satisfy the regulations 37 CFR §§1.801-1.809, including in 37 CFR §1.803(a)(1) which states that a deposit shall be recognized for the purposes of these regulation if made in any international depositary authority (IDA) as established under the Budapest Treaty. Applicants have provided three forms indicating deposits made with the ATCC on May 26, 2005, June 30, 2005, and March 8, 2006 as evidence of such deposits.

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Applicants further state that all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of a patent.

In view of the amendments and foregoing remarks, Applicants respectfully assert that the claims are in allowable condition.